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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,090	06/14/2000	MIROSLAV CHMELIR	6272-0049-0P	4228

22850 7590 11/08/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ZALUKAEVA, TATYANA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/554,090	CHMELIR ET AL.	
	Examiner	Art Unit	
	Tatyana Zalukaeva	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/31/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2004 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 24, 13-23, 25-33 are rejected under 35 U.S.C. 102(a) as being anticipated by Dahmen WO 97/06190, which is an equivalent of and has identical disclosure as U.S. 6,060,557. For convenience the columns and lines are indicated in U.S. 6,060,557 instead of WO'190.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

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reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Dahmen discloses a process for **producing a gel copolymer**, which is subsequently crosslinked, by first neutralizing acid groups of monomer(s) prior to polymerization, then polymerizing under radical conditions at temperature 5-30C (which is NOT MORE than 102-104, as per instant claim 24), gel is comminuted after polymerization and then the gel is dried (see col.2, lines 64). The compounds used for neutralization are listed as ammonia, primary and secondary amines (col. 4, lines 50-55). Prior to polymerization solution is cooled to 5-30C (col.4, lines 56-58). The polymer gel is dried at 100-190C (col.5, lines 24-27). See also example 1 for parameters of the process, such as temperatures of starting polymerization and drying. This expressly meets the limitations of the instant claims 24, 13, 14, 20, 25, 32 and 33.

With regard to claim 15, see col.2, lines 54, 55. With regard to claims 16 and 26, 27 see col.3, lines 22-25 and lines 11-20 and lines 26-35 . With regard to claim 18, vinyl acetate as a comonomer is shown in claim 14 and in col. 3, line 37. With regard to a crosslinking agents as per instant claim 19, Dahmen discloses the crosslinking of a polymer gel with crosslinking agents listed in col.3, lines 65-67, col.4, lines 1-5, which expressly meet the limitations of the instant claim 19.

4. Claims 21-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO'190

Dahmen is silent about the residual monomer content and about the time of heating.

With regard to the residual monomer content the rejection is made in the sense of *Leinoff v. Louis Milona & Sons, Inc.* 220 USPQ 845 (CAFC 1984) that holds it axiomatic that one who performs the steps of a process must necessarily produce all of its advantages. Mere recitation of a newly discovered property or **function** that is inherently possessed by the things or steps in the prior art does not cause a claim drawn to those things to distinguish over the prior art.

Therefore, the property of residual monomer content inherently flows from the substantial identity of two processes.

5. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO'190.

With regard to the time of heating, the process of Dahmen uses heating at the same temperature to achieve the less than 10% water content, which is also critical in the Applicants' invention. Therefore, it would have been obvious to those skilled in the art to find the optimum between two result effective variables (temperature and time of heating) by routine experimentation in order to achieve desirable water and residual monomer content.

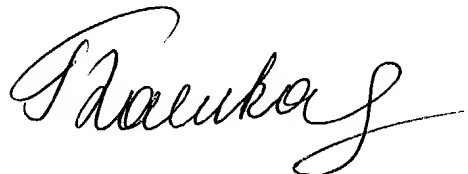
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713

October 2, 2004

A handwritten signature in black ink, appearing to read 'Tatyana Zalukaeva', written in a cursive style.